

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10005378-1

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on 1/30/06Signature Raymond A. JenskiTyped or printed name Raymond A. Jenski

Application Number

09/768,990

Filed

January 23, 2001

First Named Inventor

Diane R. Hammerstad

Art Unit

3622

Examiner

Arthur D. Duran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 31,267
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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Typed or printed name

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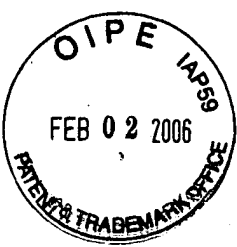
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventors: Diane R. Hammerstad **Examiner:** Arthur Duran
Application No: 09/768,990 **Group Art Unit:** 3622
Filing Date: Jan 23, 2001 **Confirmation No:** 4199
Title: Delivery Of Time Significant Advertising

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above identified application. No amendments are filed with this request. This request is filed with a Pre-Appeal Brief Request for Review and a Notice of Appeal.

REMARKS SUPPORTING REQUEST FOR REVIEW

Summary

The claims have been finally rejected under 35 USC 103(a) as being unpatentable over three references, one of which Applicant contends is not prior art. In response to the final Office Action, Applicant filed an affidavit under 37 CFR 1.131 and provided an internal company invention disclosure form as evidence of an early internal disclosure of Applicant's invention. Examiner's Advisory Action of 12/22/05 misstates the period of time between the priority date of Applicant's application and the priority date of the relied-upon reference. Examiner's Advisory Action of 12/22/05 further misstates the requirements regarding diligence. Examiner's Advisory Action of 12/22/05 is missing an explanation of a deficiency in the showing of the conception of Applicant's invention. Examiner's Advisory Action of 12/22/05 is further missing an explanation of the lack of showing of the alleged reduction to practice.

Status of the Application

The Application has been finally rejected under 35 USC 103(a) as being unpatentable over USP 5,937,392 to Alberts ("Alberts") in view of USP 6,047,327 to Tso et al. ("Tso") in view of US Patent Application No. 2002/0082912 to Batachia ("Batachia"). In the Office Action mailed 10/31/05, Examiner stated that Applicant's Amendment filed on 9/26/05 was

sufficient to overcome the prior rejection. See O.A. 10/31/05, p. 2, "Response to Amendment". The prior rejection (Office Action, mailed 5/20/05) rejected all claims under 35 USC 103(a) as being unpatentable over Alberts in view of Tso. See O.A. 5/20/05, pp. 5 and 8. Therefore, Applicant concludes that Examiner believes the new combination including Batachia of the final office action brings additional teachings that make obvious claims 1-6 and 9-13. But, the Batachia is not prior art and therefore cannot be entangled with Alberts and Tso to create a §103(a) rejection where Alberts and Tso have already been acknowledged to be insufficient to do so.

Priority Dates

Applicant has submitted an affidavit under 37 CFR 1.131, declaring and showing facts that demonstrate prior invention by Applicant. Examiner, in the Advisory Action mailed 12/22/05, misstated the amount of time between the priority date of Batachia and Applicant's priority date. The actual amount of time is 32 days; not greater than one year, as asserted. Accordingly, Examiner's second and fourth paragraphs on page 2 of the 12/22/05 Advisory Action should be withdrawn.

Diligence

Examiner believes Applicant's affidavit to be ineffective to establish diligence from a date prior to the priority date of Batachia to Applicant's reduction to practice. See Advisory Action, 12/22/05, p. 2, ¶3. Examiner is required to provide reasons for a holding of non-diligence in the instance of a constructive reduction to practice. Examiner states that Applicant must demonstrate "daily and continued detailed work" on the invention. Applicant cannot find statutory or administrative support for this intensive requirement. Applicant believes Examiner has reached beyond his authority with this request and therefore it is improper. Applicant respectfully requests this paragraph 3 be withdrawn.

Conception Date

Examiner believes Applicant's affidavit to be ineffective to establish a conception of the invention prior to the priority date of Batachia. See Advisory Action, 12/22/05, p. 2, ¶5. Examiner is required to provide an explanation of deficiency in Applicant's affidavit. Examiner has not done so. Applicant is unable to properly respond to such an unexplained

finding of deficiency. Accordingly, Applicant respectfully requests paragraph 5 to be withdrawn.

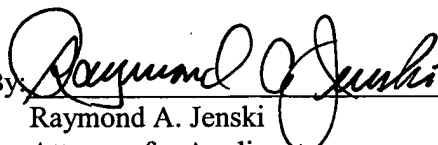
Reduction to Practice

Examiner believes the evidence submitted in Applicant's affidavit to be insufficient to establish a reduction to practice of the invention prior to the priority date of Batachia. See Advisory Action, 12/22/05, p. 2, ¶6. Examiner is required to provide an explanation of insufficiency in Applicant's affidavit. Examiner has not done so. Applicant is unable to properly respond to such an unexplained finding of insufficiency. Accordingly, Applicant respectfully requests paragraph 6 to be withdrawn.

In view of the foregoing, Applicant believes the Advisory Action of 12/22/05 to be inappropriate and respectfully requests a finding of sufficiency of Applicant's affidavit and a withdrawal of the Advisory Action. Further, with the removal of Batachia as prior art to Applicant's Application, Applicant respectfully requests the Application as previously amended be allowed.

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Respectfully submitted,
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Date: 1/30/06